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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,911	10/12/2001	Harold Ferdinand Van Garderen	0142-0362P	8931
2292	7590	08/28/2007	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				TANG, KENNETH
ART UNIT		PAPER NUMBER		
2195				
NOTIFICATION DATE			DELIVERY MODE	
08/28/2007			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/974,911	VAN GARDEREN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kenneth Tang	2195	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 April 2007.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

1. This action is in response to the Amendment on 4/30/07. Applicant's arguments have been fully considered but were not found to be persuasive.
2. Claims 1-5 are presented for examination.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-3 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Whitmarsh et al. (hereinafter Whitmarsh) (US 7,042,585 B1).**

4. As to claim 1, Whitmarsh teaches a distributed document handling system for carrying out jobs, where jobs are carried out by services distributed over a network and where a job leads to a product, the system comprising:

a pool of services, the services being distributed over a number of interconnected processing devices (col. 5, lines 1-9);  
specifying means for entering by a user a job specification comprising product specifications specifying the product to be delivered by the job and specifications specifying circumstantial constraints without effect on the product (wherein price is attribute), in

considering selection from the pool of services (col. 10, lines 9-21 and 59-65, col. 11, lines 22-39, col. 5, lines 48-61);

determining means for determining a path of services, a path comprising at least two services ("Print services 18, as used herein, is defined to include printing services, finishing services, delivery services, and/or other print processing services", col. 3, lines 50-53), the services being selected from the pool of services, wherein the path is suitable to carry out the job in accordance with the product specifications, and wherein the determining means is operable to take into account circumstantial constraints for that job (paths are determined based on price and are sorted or ranked based on price) (col. 11, lines 31-39).

user interface means for presenting the paths suitable to carry out the job (col. 4, lines 49-67, col. 5, lines 1-9, Fig. 2, items 24 and 46);

user interface means for, after the paths have been presented, enabling modification of the job specification by the user (attributes are entered via user interface and can be changed dynamically) (col. 5, lines 48-61, col. 11, lines 14-39, see Fig. 1 and 3, item 26, and Figs. 4-5); and

means for, upon modification of the job specification, involving the determination means again for determining a path of services, based on the modified job specification (col. 5, lines 48-61, col. 11, lines 14-39).

5. As to claim 2, Whitmarsh teaches the distributed document handling system wherein:  
a circumstantial constraint defines a limit in an ordered range (col. 11, lines 23-24); the system also comprises:

means for ranking paths suitable to carry out the job in accordance with the ordered range of the circumstantial constraint (col. 11, lines 23-39); and user interface means for selection by the user of a desired job specification from a ranked list of job specifications based on the ranked paths (col. 10, lines 9-21 and 59-65, col. 11, lines 22-39, col. 5, lines 48-61).

6. As to claim 3, Whitmarsh teaches wherein the system also comprises user interface means for selection by the user of the circumstantial constraint to be used in the ranking of the paths (col. 11, lines 22-58).
7. As to claim 5, Whitmarsh teaches wherein the processing devices are connected to each other by a local area network or the Internet (col. 3, lines 25-40).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitmarsh et al. (hereinafter Whitmarsh) (US 7,042,585 B1) in view of Nakajima (US 2002/0107817 A1).**

9. As to claim 4, Whitmarsh is silent in calculating the total price from the price attributes of services included in a determined path. However, Nakajima teaches a network printing system that has a summing means that calculates the total charge/price for printing services, for example ([0011]. Whitmarsh and Nakajima are analogous are because they are both in the same field of endeavor of network printing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Whitmarsh's network printing system to include the features of a summing means that calculates the total charge/price for printing services, as shown in Nakajima's network printing system. The suggestion/motivation for doing so would have been to efficiently determined how much the customer needs to be charged ([0010]-[0011]). Therefore, it would have been obvious to combine Whitmarsh with Nakajima to obtain the invention of claim 4.

#### *Response to Arguments*

10. During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

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11. *Applicant states that the Examiner's rejection in view of the Whitmarsh reference is misstated because the rejection should be made under 102(e) and not 102(b).*

In response, the Examiner is confused about this statement. The Examiner's rejection was based on 102(e), not 102(b) (See Office Action on 11/28/06, Paragraph #6)

12. *Applicant argues on pages 8-12 of the Remarks that Whitmarsh teaches that the print provider 16 only has a service, namely "print services 18", while the amended claims illustrate the path comprising at least two services.*

In response, the Examiner respectfully disagrees. Whitmarsh literally states "Print services 18, as used herein, is defined to include printing services, finishing services, delivery services, and/or other print processing services" (see col. 3, lines 50-53). Printing services, finishing services, delivery services, and/or other print processing services are clearly at least two services, and therefore, the print provider 16 provides print services 18, which are clearly at least two services.

13. In response to applicant's argument, on pages 10-11 of the Remarks, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a path will be determined by combining services in a sequence that will fulfill the requirements of the user as good as possible" and the conversion service example given by the Applicant) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

14. *Applicant argues that there is no disclosure in Whitmarsh of a user interface means that enables modifications of the job specification of the user.*

In response, Whitmarsh teaches a print provider interface 26 that enables modifications of the job specification of the user (see Fig. 1 and 3, item 26, and Figs. 4-5, col. 5, lines 48-61, col. 11, lines 14-39).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Tang whose telephone number is (571) 272-3772. The examiner can normally be reached on 8:30AM - 6:00PM, Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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8/14/07

  
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